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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,868	01/25/2002	Thibaut Montanari	ATOCM-245	8547

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/054,868

Applicant(s)

MONTANARI ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 17, 24, 25 and 35-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-16, 18-23, 26-34 and 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 6-8, 17, 24, 25 and 35-39 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper filed October 15, 2003.

### *Claim Rejections - 35 USC § 112*

2. Claims 1-5, 9-16, 18-23, 26-34 and 40-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the generic “copolyamides” defining component C) is generic to components (A) and (B). Accordingly, it is unclear as to whether or not component C can be the same entity as either one of A and B.

In claim 1, the language “at least one monomer chosen from” constitutes improper Markush group format.

In claim 1, the language “copolymers containing polyamide blocks, polyether blocks and copolyamides” is indefinite and not understood. Do said “copolymers” contain all three recited materials?

In claim 1, the term “compatabilizer” is misspelled.

Claims 9 and 11 are essential duplicates of each other since it is understood that the PA-11 of claim 9 would be catalyzed.

***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,4,5, 12-16, 18, 19, 22, 23, 27, 28, 30, 32, 33 and 42-44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0070001 previously discussed.

The compositions of the reference meet the requirements of the present claims, as presently recited, when the copolyamide component C) is interpreted as being the same entity as either one of components A) or B). That is, either one of the semi-crystalline or amorphous polyamides of the reference would also meet applicants' copolyamide C).

6. Claims 1, 4, 5, 12-16, 18, 19, 22, 23, 27, 30, 32, 33 and 42-44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,288,799 (Schmid et al) previously discussed.

The compositions of the reference meet the requirements of the present claims, as presently recited, when the copolyamide component C) is interpreted as being the same entity as

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either one of components A) or B). That is, either one of the semi-crystalline or amorphous polyamides of the reference would also meet applicants' copolyamide C).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 20, 21, 26, 28, 29, 31 and 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,288,799 (Schmid et al) as per reasons of record.

9. Claims 2, 3, 20, 21, 26, 29, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0070001 as per reasons of record.

10. Claims 1-5, 9-16, 18-23, 26-34 and 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,416,172 (Blondel et al).

Blondel et al disclose transparent polyamide compositions containing from 1 to 99% by weight of a first polyamide consisting of aliphatic units containing at least 7 carbon atoms, isophthalic and terephthalic diacids and cycloaliphatic diamine units and from 99 to 1% by weight of a semi-crystalline polyamide consisting of at least 35% by weight of an aliphatic unit containing at least 7 carbon atoms. The composition may contain **catalysts**, stabilizers and also other polymers such as **another amorphous or semi-crystalline polyamide** (column 6, lines 31-35).

Patentees' first polyamide meets applicants' amorphous polyamide (B). Note that said first polyamide may additionally comprise other monomer units such as amino acids, aliphatic

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diacids and diamines (per instant claim 18). Patentees' semi-crystalline polyamide, advantageously chosen from the PA 12, PA 11 and copolymers thereof (column 5, lines 40-44), meets applicants' semi-crystalline polyamide (A). The "another amorphous or semi-crystalline polyamide" meets applicants' catalyzed polyamide (D), as will be discussed hereinbelow. The polyamides are mixed in the presence of a catalyst, such as phosphoric acid (column 9, lines 29-33).

The reference differs in essence from the elected embodiment of the present claims, i.e., containing the catalyzed polyamide (D), in not expressly exemplifying a composition containing three polyamides wherein one is semi-crystalline, one is amorphous and one is catalyzed. It is within the scope of the reference, however, to prepare a composition by mixing a semi-crystalline polyamide, an amorphous polyamide and an additional polyamide in the presence of a catalyst. It is reasonably believed that said three polyamide-containing composition would meet the requirements of the applicants' elected embodiment because the polyamides would necessarily contain the catalyst "during the subsequent steps of the preparation of the compositions". It is noted that in the present invention, "the catalyst may be added to the polyamide (D) **after it has been prepared**". Accordingly, no patentability can be seen in the presently claimed subject matter.

It should also be noted that Blondel et al would similarly make obvious the non-elected embodiment containing polyamide (C).

### ***Double Patenting***

11. Claims 1-5, 9-26, 28-23, 26-34 and 40-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-14

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and 16-19 of copending Application No. 10/416,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application also claims a composition comprising a semi-crystalline polyamide, a prepolymeric polyamide and an amorphous polyamide, wherein at least one of said polyamides contains a catalyst.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Response to Amendment***

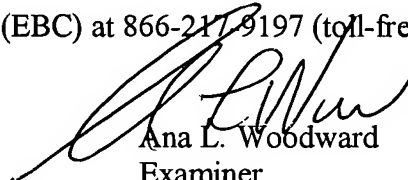
13. Applicant's arguments filed March 3, 2004 have been fully considered but they are not persuasive. The compositions of the EP'001 and US '799 references meet the requirements of the present claims, as presently recited, when the copolyamide component C) is interpreted as being the same entity as either one of components A) or B). That is, either one of the semi-crystalline or amorphous polyamides of the references would also meet applicants' copolyamide C).

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ana L. Woodward  
Examiner  
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